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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN E. AUPPERLE, SAJAN K. SANKARAN,
SPENCER H. SHEPARD, IV, and YIH-SHIN TAN

Appeal 2008-1555
Application 10/060,996
Technology Center 3600

Decided: September 30, 2008

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID
B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) (2002) from the final rejection of claims 4, 7, 8, and 11. We reverse.

Representative claim 4 reads as follows:

4. A method of cooperatively processing e-business transactions in an e-business complex comprising the steps of:

registering a plurality of virtual store operators with the e-business complex, each said registration establishing a virtual store in the e-business complex;

providing to individual ones of on-line shoppers in the e-business complex, window displays of products offered for sale by virtual stores in the e-business complex, and accepting shopper orders for said products from said individual on-line shoppers;

notifying selected store operators of said shopper orders, said selected store operators operating virtual stores in the e-business complex which correspond to said products ordered by said on-line shoppers;

notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators;

fulfilling said shopper orders with said products supplied by said selected vendors;

collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators;

providing to said store operators a catalog of professional services offered for sale by associated professional services providers; and,

brokering at least one transaction for at least one of said professional services between at least one of said store operators and at least one of said professional service providers.

The references set forth below are relied upon as evidence in support of the rejection:

Horn	US 2002/0156688 A1	Oct. 24, 2002
Lee	US 2005/0187866 A1	Aug. 25, 2005

Claims 4, 7, 8, and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Conklin in view of Horn and further in view of Lee. The dispositive issue is whether the combination asserted by the Examiner teaches providing to said store operators a catalog of professional services offered for sale by associated professional services providers.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

The two independent claims, 4 and 8, respectively require, 1) providing to said store operators a catalog of professional services offered for sale by associated professional services providers; and 2) a computer program stored on a machine readable storage, comprising a routine set of instructions for causing the machine to perform step 1.

The Examiner interpreted the claimed phrase, “a catalog of professional services” as a record of professional services available for selection. The Examiner found that Lee’s disclosure that the user is allowed to select a legal counsel or other external professionals from a list of

attorneys or a group of law firms that describes the kind of legal work they do represents a catalog or a record or a list of available/offered professional services from which the user can select (Answer 11, citing Lee, 6:[0075]-[0076] and Figure 6).

The Appellants argue that providing access to service professionals as taught in Lee is not the same as providing a catalog of professional services offered for sale as claimed (Br. 6). According to Appellants,

Even if the [*sic*] Lee taught providing a list of service professionals that could be contacted by a user, this teaching still would not teach or suggest the claimed “catalog of professional services offered for sale.” For example, the Examiner referred to paragraph [0075] of Lee, which teaches two different ways a user may seek and engage external professional services. One option is to “send an invitation to various attorneys 76 or a group of law firms describing the kind of legal work required and requesting an estimate of the legal fees,” and another option is that “a user may hold a separate auction 76 on the system, through which legal counsel or a law firm(s) may bid for the work.”

(Br. 6).

Appellants also argue that the Examiner has improperly misrepresented the teachings of Lee. Specifically, the Examiner asserted that Lee teaches “wherein the list of attorneys or a group of law firms describing the kind of legal work they do represent[s] a catalog or a record or a list.” (Reply Br. 7). The Appellants argue that it is evident from the passage of Lee relied upon by the Examiner (Lee, 6:[0075]-[0076]) that “the user describes ‘the kind of legal work required.’ The Examiner's improper

misstatement is that Lee teaches that ‘attorneys or a list of firms [describe] the kind of legal work they do.’ Thus, the Examiner's analysis is predicated on an improper interpretation of the teachings of Lee.” *Id.*

We agree with the Appellants. We find the Examiner’s findings to be inconsistent with the teachings of Lee. The Examiner found that Lee allows a user to select legal counsel or other external professionals from a list of attorneys that describes the kind of legal work they do (Answer 11). In fact, the only reference in Lee to a description of legal work is the description provided by a user in a request for bids (Lee, 6:[0075]). We find no teaching of a record of professional services available for selection, which is the Examiner’s definition of a catalog of professional services. We find that, even under a broadest reasonable interpretation in light of the Specification, Lee does not teach providing to said store operators a catalog of professional services offered for sale by associated professional services providers. At best, Lee appears to teach methods to solicit bids for legal services either by direct invitation or by holding an auction. We find no teaching of offering to the user a catalog of professional services offered for sale. Because each of the appealed claims requires providing to said store operators a catalog of professional services offered for sale by associated professional services providers, the Examiner has failed to establish a prima facie case of obviousness of claims 4, 7, 8, and 11 over Conklin in view of Horn and further in view of Lee.

Appeal 2008-1555
Application 10/060,996

The decision of the Examiner is reversed.

REVERSED

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